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Joshua E. Garfield (Reg. No. 58,416)
Name of applicant, assignee or
Registered Representative

/Joshua E. Garfield/
Signature

Our Case No. 10022/142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Dempski et al.

Serial No.: 09/924,669

Filing Date: August 8, 2001

For : ENHANCED CUSTOM CONTENT
TELEVISION

Examiner: S. Chowdhury

Group Art Unit No.: 2623

Conf. No.: 3664

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Assignee requests review of the Final Office Action mailed June 23, 2008 for the above-identified patent application. No amendments to the claims are being filed with this request.

Assignee is filing this request with a Notice of Appeal. Assignee is requesting review for the reasons stated on the attached sheets. No more than five (5) pages are provided.

I. Introduction

A. Pending Claims

Claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52 are currently pending.

B. Summary of Rejections

In the Final Office Action mailed June 23, 2008 ("Final Office Action"), claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52 were rejected under 35 U.S.C. § 103(a).

In particular, claims 1, 4, 7-8, 10, and 45-46 were rejected as being unpatentable over Canadian Pat. App. No. 2,387,386 to Akiyama *et al.* ("Akiyama") in view of U.S. Pat. No. 7,020,888 to Reynolds *et al.* ("Reynolds"), U.S. Pat. No. 7,159,232 to Blacketter *et al.* ("Blacketter"), U.S. Pat. App. Pub. No. 2002/0063714 to Haas *et al.* ("Haas"), and U.S. Pat. No. 6,698,020 to Zigmond *et al.* ("Zigmond"). In addition, claims 11, 13-15, 17-20, and 48-49 have been rejected as being unpatentable over Akiyama in view of Reynolds, Blacketter, Haas, and Zigmond. Furthermore, claims 37, 40, 42, and 52 have been rejected as being unpatentable over Akiyama in view of Reynolds, Blacketter, Haas, and Zigmond. Moreover, claim 38 has been rejected as being unpatentable over Akiyama in view of Reynolds, Blacketter, Haas, Zigmond, and U.S. Pat. App. Pub. No. 2003/0016673 to Pendakur *et al.* ("Pendakur"). Finally, claim 43 has been rejected as being unpatentable over Akiyama in view of Reynolds, Blacketter, Haas, Zigmond, and U.S. Pat. No. 6,437,836 to Huang *et al.* ("Huang").

II. The Proposed Combination of Akiyama, Reynolds, Blacketter, Haas, and Zigmond Does Not Teach Or Suggest All Of The Features Of Independent Claims 1, 11, and 37

A. Akiyama does not teach or suggest "determining whether a television broadcast has resumed after end of a television broadcast advertisement or "determining whether a next sequential program segment in the television broadcast program has commenced after end of the blocked television broadcast segment"

Claims 1 and 11 are directed methods for enhancing a television broadcast program. Claim 1 recites "determining whether the television broadcast program has resumed after end of the television broadcast advertisement" and claim 11 recites "determining whether a

next sequential program segment in the television broadcast program has commenced after end of the blocked television broadcast segment." Claim 37 is directed to a system for displaying enhanced television broadcast programs and recites that a multimedia controller is operative "to determine whether the television broadcast program has resumed after the end of the television broadcast advertisement." The Final Office Action asserts that Akiyama teaches these features. (See Final Office Action, pp. 3, 10, 19). Assignee respectfully maintains that Akiyama does not teach or suggest these features.

In the embodiment of Akiyama relied upon by the Final Office Action, Akiyama explains that a selective display process is responsible for replacing a commercial originating from a tuner with a commercial originating from a hard disk memory. During the selective display process, a CF code for a commercial is determined from an advertiser/commercial table based on a viewer's attribute. (See Akiyama, p. 26, ll. 23-27). After determining the CF code for the replacement commercial, the selective display process waits for a timer interrupt to occur. When the timer interrupt occurs, the selective display process activates a switcher to read the commercial with the selected CF code from the hard disk memory. The commercial with the selected CF code is then sent to a decoder for decoding and selective display process effectively replaces the commercial originating from the tuner.

The Advisory Action mailed October 9, 2008 is clearly wrong to assert that the "user determines that a TV program resumes," and that this discloses the claimed limitation. The selective display process in Akiyama does not determine whether a television broadcast program has resumed after the end of the replacement commercial. Akiyama explains that the selective display process waits for the content of the replacement commercial to be read out. When the selective display process finishes the readout of the replacement commercial, the selective display process sets the switcher back to an original state, and re-establishes the path between the tuner and the decoder, such that the television broadcast program is displayed at its current scheduled broadcast point. (Akiyama, p. 27, ll. 6-10). The selective display process focuses on the duration of the replacement commercial and does not focus on whether the broadcast of the original television programming has resumed or whether the broadcast commercial is still continuing.

Accordingly, Akiyama does not teach or suggest the features of claims 1, 11, and 37 as asserted by the Final Office Action.

B. Zigmond does not teach or suggest retaining a viewer selection of at least one modification to a first replacement advertising segment as part of a viewer profile or automatically applying a previously retained viewer selection of at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment"

Claims 1 and 11 are directed to developing a viewer profile that includes retaining a viewer selection of at least one modification to a first replacement advertising segment as part of the viewer profile, and automatically applying the previously retained viewer selection of the at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. Claim 37 is directed to a first memory that is further operative to retain a viewer selection of at least one modification to a first animated video replacement advertising segment as part of a viewer profile used in selecting the first animated video replacement advertising segment, and that a processor is further operative to automatically render the at least one previously received modification retained by a first memory storage to a second animated video replacement advertising segment that is selected after the first animated video replacement advertising segment. The Final Office Action asserts that Zigmond teaches these features. (See Final Office Action, pp. 8, 15, 24). Assignee respectfully maintains that Zigmond does not teach or suggest these features.

Zigmond is generally directed to methods and systems for inserting advertisements or other video or visually displayed objects into video programming feeds at the household level. According to Zigmond, these methods allow advertisers to target individual viewers based on the needs and interests of individual viewers and households. (Zigmond, col. 4, ll. 7-12). In one embodiment, Zigmond discusses a viewer monitoring feature that monitors viewer interactions with an advertisement. (Zigmond, col. 9, ll. 20-22). In this embodiment, the viewer monitoring feature monitors viewer actions and responses such as channel changes during the display of an advertisement, feedback provided by the viewer, or an advertisement selection when the viewer is presented with multiple advertisements. (Zigmond, col. 9, ll. 22-37). Zigmond explains that the viewer actions may be collected as part of statistics collection or may be used to modify the advertisement selection process. (Zigmond, col. 9, ll. 39-55).

The Final Office Action asserts that Zigmond teaches the features of claims 1, 11, and 37 because Zigmond teaches "retaining the viewer selection of the at least one **interaction** with the first replacement advertising segment." (See Final Office Action, pp. 8, 15, 24). However, the claims are directed to "**modifications**" of a first replacement advertising

segment. Zigmond is not related to modifying replacement advertisements. Zigmond primarily focuses on monitoring viewer responses to an advertisement. As discussed above, Zigmond monitors viewer responses relating to an advertisement, such as whether the viewer changes the channel or provides feedback for an advertisement, but Zigmond does not monitor modifications to an advertisement. Changing the channel on which an advertisement is displayed does not modify the advertisement, but changes the channel itself.

Moreover, Zigmond does not describe automatically applying a previously retained viewer selection of at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. Modifying the selection process for selecting an advertisement does not modify the advertisement, but modifies whether the advertisement is selected.

Accordingly, Zigmond does not teach or suggest the features of claims 1, 11, and 37 as asserted by the Final Office Action.

III. Akiyama Teaches Away from Blacketter

The teaching-suggestion-motivation test is not a "rigid rule that limits the obviousness inquiry." (*KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)). However, the conflicting teachings of references cannot be reasonably viewed as suggesting their combination. (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001)). Moreover, where a first reference teaches away from a second reference, there can be no teaching or suggestion to combine the two references. (*Winner Int'l Royalty Corp. v. Wang*, 53 U.S.P.Q.2d 1580, 1587-88 (Fed. Cir. 2000)).

Akiyama teaches away from Blacketter because the accuracy and predictability found in Akiyama conflicts with the dynamic features described in Blacketter. For example, Akiyama relies on preconfigured schedules and a program table that detail the start and duration times of television programs and advertisements. (Akiyama, pp. 22-25, Figs. 8-10). Akiyama operates by inserting replacement content into the television programs according to these received preconfigured schedules. Akiyama does not describe or suggest that the schedules or the times are modifiable after being received. Moreover, Akiyama does not describe or suggest a mechanism for altering the preconfigured schedules. A viewer using the system of Akiyama cannot change the duration of the replacement content nor can the viewer affect when the replacement content appears. However, the preconfigured schedules and the

program table are fundamental to the operation of Akiyama. Akiyama relies on these static features to accurately and predictably determine the occurrence of the broadcast commercial to be replaced and the duration of the replacement content replacing the broadcast commercial.

In contrast, Blackketter emphasizes that a viewer controls the occurrence and duration of the interactive sessions. (Blackketter, col. 9, ll. 14-55). As Blackketter illustrates, the interactive sessions do not rely on preconfigured schedules, nor do the interactive sessions rely on the duration of any advertisements. The system described by Blackketter obviates any concept of predictability or accuracy that is found in Akiyama. One of ordinary skill in the art looking at Akiyama for the accuracy and predictability that Akiyama provides would not then turn to Blackketter to determine how to nullify that accuracy and predictability.

Like the impermissible combinations found in *Karsten Mfg. Corp.* and *Winner Int'l Royalty Corp.*, so too is the combination of Akiyama with Blackketter impermissible. While Akiyama and Blackketter may be related, the teachings of Akiyama conflict with the teachings of Blackketter. However, while the references were related in *Karsten Mfg. Corp.* and *Winner Int'l Royalty Corp.*, the Federal Circuit looked to the conflicting teachings of the references to determine that the references taught away from their combination.

IV. Conclusion

For at least the above reasons, Assignee respectfully requests review of the Final Office Action for current application and withdrawal of the rejections against the pending claims.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

/Joshua E. Garfield/
Joshua E. Garfield
Registration No. 58,416
Attorney for Assignee